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RJH
Paper No. 2A

In re Application of:
MEISSNER ET AL.
Serial No.: 09/393,023
Filed: September 09, 1999
For: Human Criptin Growth Factor

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.144, filed March 27, 2002, to withdraw the restriction requirement.

Initially it is noted that on April 11, 2002, a petition decision was inadvertently mailed to applicants. That decision was mailed prematurely. Consequently, that decision is hereby vacated in favor of this decision. Any confusion or problems caused by this inadvertent mailing is sincerely regretted.

Status of Application

On December 13, 2000, a restriction requirement was mailed to applicants. On May 17, 2001, applicants elected an invention with traverse, canceled claims 1-13, 15, and 17-18, and added new claims 21-95. On July 6, 2001, another restriction requirement was mailed to applicants in view of the many new claims added by the May 17, 2001 paper. On September 5, 2001, applicants again elected an invention with traverse. On November 26, 2001, a non-final Office action was mailed to applicants that rebutted applicants' traversal of the restriction requirement and made the restriction final. On March 27, 2002, the present petition was filed.

Petitioner's Arguments

Petitioner asserted that the restriction requirement is improper because the examiner failed to consider whether the claimed inventions were "independent" as required by the plain and unambiguous meaning of 35 U.S.C. § 121, and asserts that the examiner improperly concluded that the separately claimed inventions are "distinct." Specifically, petitioner notes that 35 U.S.C. § 121 states (emphasis added):

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions.

From this, petitioner concluded that while the examiner presented reasons why the inventions are "distinct," the examiner did not present any reasons why the inventions were "independent" and, therefore, the examiner did not meet the statutory requirement for restriction.

Petitioner also argued that even if the inventions only have to be distinct from each other for the restriction to be proper, in this case the inventions restricted from each other, a full length sequence and fragments and variants of the sequence, are related as combination and subcombination inventions. As such, two-way distinctness is required. The petition puts it this way:

The full-length claims and the fragment and variant claims are not "two-way" distinct. For example, if the polypeptide of the full-length claims (i.e., the combination) was known in the art before the invention of the polypeptides of the fragment and variant claims (the subcombination claims), the subcombinations would not be patentable as claimed. This is because the full-length sequence would anticipate the fragment and variant claims. Thus, the Examiner erred in concluding that claims 21-95 are patentably distinct.

To support this position, petitioner includes on page 5 of the petition a quote from the USPTO that discusses viewing genes and nucleic acids as being combinations of sequences that are subcombinations. See page 5 of the petition as well as Exhibit G of the petition.

Response to Petitioner's Arguments

The argument regarding "independent and distinct" is not persuasive. The MPEP makes it clear that the USPTO interprets the "independent and distinct" language of the statute in such a way that restriction is proper as long as the inventions are independent or as long the inventions are distinct. In other words, the USPTO interprets the "independent and distinct" language of the statute as "independent or distinct". See the explanation provided in MPEP section 802.01. Furthermore, it is noted that applicant's prior replies to the restriction requirement acknowledged that the standard for restriction requires independent or distinct inventions and a serious search burden. See page 2 of paper filed 9/5/01 and pages 13-14 of paper filed 5/17/01.

However, in reviewing the restriction requirement as a result of petitioner's remaining arguments, it was determined that the Groups as presented by the examiner were not entirely independent from each other or patentably distinct from each other. Consequently, the petition is hereby granted to the extent that the restriction requirement as it currently stands and the last Office action (dated November 26, 2001) are hereby

Application Serial No. 09/153,023
Technology Center 1600

--3--

vacated. The application has been forwarded to the examiner for appropriate action consistent with this decision, e.g., a new restriction requirement.

PETITION GRANTED but only to the extent that the restriction requirement as it currently stands and the last Office action (dated November 26, 2001) are hereby vacated.


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